



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,887	12/13/2000	Krishna A. Bharat	0026-0004	5677

44989 7590 09/14/2005

HARRITY & SNYDER, LLP
11240 WAPLES MILL ROAD
SUITE 300
FAIRFAX, VA 22030

EXAMINER

MIZRAHI, DIANE D

ART UNIT	PAPER NUMBER
----------	--------------

2165

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,887

Applicant(s)

BHARAT ET AL.

Examiner

DIANE D. MIZRAHI

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

D

Art Unit: 2165

III. Detailed Action

Claims 1-23 and Applicant's new added claims 24-40 are currently pending.

All previous presented rejections of all the claims are hereby withdrawn as to being moot. Examiner formally withdraws indication of allowability presented in the office action dated March 22, 2005. Please see new office action rejection below:

Claim Rejections - 35 USC , 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title.

Claims 21-22 represents a data structure that does not provide a practical application in the technological arts. There is no manipulation of data nor is there any transformation of data from one state to another state being performed in "... containing a data structure". Containing a data structure" does not perform a physical transformation. Ergo, no physical transformation is performed, no practical application is found.

Art Unit: 2165

Consequently, the claims are thus rejected as being directed.

The Supreme Court has repeatedly held that abstractions are not patentable. "An idea of itself is not patentable". Rubber-Tip Pencil Co. V. Howard, 20 Wall. 498, 07. Phenomena of nature, though just discovered, mental processes, abstract intellectual concepts are not patentable, as they are the basic tools of scientific and technological work Gottschalk v. Benson, 175 USPQ 673, 675 (S Ct 1972). It is a common place that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter Parker v. Flook, 197 USPQ 193, 201 (S Ct 1978). A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See In re Warmerdam, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also Schrader, 22 F.3d at 295, 30 USPQ2d at 1459.

Claims 9, 20, 24-29 and 33-40 are rejected under 35 U.S.C. 101 because the claims are directed to a non-statutory subject matter. Claims 9, 20, 24-29 and 33-40 are not statutory. "The term "computer-readable medium" as used herein, refers to any medium that provides information or is usable by the processor. Such medium can

Art Unit: 2165

take many forms including but not limited to non-volatile and volatile, and transmission media Transmission media can take the form of carrier waves, i.e. electromagnetic waves that can be e modulated, as in frequency, amplitude, or phase, to transmit information signals. Additionally, transmission media can take the form of acoustic or light waves, such as those generated during radio wave and infrared data communications".

To overcome this type of 101 rejection the claims need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media. For the specification at the bottom, carrier medium and transmission media would be not statutory but a tangible storage media would be statutory.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2165

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-12, 15-17, 19-21, 23-28, 30-34, 36-38 and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Gary B. Robinson (US Patent No. 5,918,014 and Robinson hereinafter) in view of Conklin et al. (U.S. Patent # 6,363,378).

Regarding Claim 1, Robinson teaches receiving a search query (i.e. reads on the search algorithm successively tests possible values for P.sub.A at certain fixed intervals) (col 17, lines 49-57) theme of a group of query themes (i.e. screensavers... free of charge, would be likely to be downloaded from the Web by quite a few users) (col 41-44) see also (i.e. users could be motivated to download the tracking software which reads on Applicant's free downloading) (col 11, lines 26-41); ranking the one or more objects based on a result of the determination (i.e. nth ad in the demographic-based ranking and the mth ad in the

Art Unit: 2165

"pure ACF" ranking; the combined rank could be $(n+m)/2$ (col 18, lines 31-38) and proving the ranked one or more objects (col 18, lines 31-43).

Robinson does not expressly teach retrieving one or more objects in response to at least one query; determining whether the search query corresponds to at least one query

Conklin teaches retrieving one or more objects in response to at least one query (i.e. query ... document hit list defines a plurality of topics) (col 6, lines 1-22) determining whether the search query corresponds to at least one query (col 3, lines 67 - col 4, lines 1-8)

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Robinson with the teachings of Conklin to include teach retrieving one or more objects in response to at least one query; determining whether the search query corresponds to at least one query with the motivation to provide for the retrieval of relevant information easily (Conklin, col 1, lines 42-43) and to evaluate the effectiveness of information (col 1, line 33).

Regarding Claim 2, Robinson teaches wherein the objects include web pages (col 3, lines 29).

Art Unit: 2165

Regarding Claim 3, Robinson teaches determining whether any of the one or more objects relates to a list of favored (i.e. the URL of each page) (col 11, lines 5-10) see also (free of charge, would be likely to be downloaded from the Web by quite a few users) (col 41-44) (col 6, line 34) see also (a favored list such as "www.ffly.com") (col 2, lines 41-44) and non-favored sources (i.e. disinteret in an ad) (col 2, lines 43-48) (i.e. the user would simply become use to it and would therefore com to ignore it which reads on misinformation) (col 4, lines 51-67) see also (col 3, lines 28-34) see also (i.e. to reject an ad reads on Applicant's misinformation or over promotion) (col 4-9).

Regarding Claim 4, Robinson teaches determining a score for those objects that are unrelated to the list of (col 17, lines 65-67 to col 18, lines 1-21) favored and non-favored (i.e. the URL of each page) (col 11, lines 5-10) see also (free of charge, would be likely to be downloaded from the Web by quite a few users) (col 41-44) (col 6, line 34) see also (a favored list such as "www.ffly.com") (col 2, lines 41-44) and non-favored sources (i.e. the user would simply become use to it and would therefore com to ignore it which reads on misinformation)

Art Unit: 2165

(col 4, lines 51-67) see also (col 3, lines 28-34) see also (i.e. to reject an ad reads on Applicant's misinformation or over promotion) (col 4-9) sources using a first group of parameters (col 3, lines 3-15) determining a score for those objects that relate to the list of favored ((col 3, lines 3-15) ... and an editorial opinion parameter (i.e. allow an advertiser to identify a particular ad, and then it would allow him to specify the sites (subject groups, pages) which have Smart Ad Boxes but which he would rather not allow to show his ad) (col 5, lines 59-67) (i.e. rules) (col 5, lines 10-13) see also (col 2, lines 63-64), and ranking the objects based on the determined scores (col 17, lines 65-67 to col 18, lines 1-39).

Regarding Claim 5, Robinson teaches editorial opinion parameter causes the rank... to favored sources to be increases and rank of those objects corresponding to non-favored sources to be decreased (col 5, lines 59-67) see also (col 3, lines 1-39).

Regarding Claim 6, Robinson teaches determining whether the search query corresponds to a query rule (i.e. reads on the search algorithm) associated with each query theme (i.e. reads on online stores ... as well prices of

Art Unit: 2165

those items... user-supplied ratings ... selection of web ads) (col 2, lines 32-48) (i.e. special Web pages or sites are supplied which enable advertisers to specify specific specific sites they would like their ads to run on (or not run on); similarly, special Web pages or sites are supplied which enable Web site administrators to specify ads they would like to display or not display) (col 3, lines 29-34).

Regarding Claims 8-12, 15-17, 19-21, 23-28, 30-34, 36-38 and 40 these are similar in scope to the rejected claims above and are therefore rejected as set forth above.

Claims 7, 13-14, 18, 22, 29, 35 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Gary B. Robinson (US Patent No. 5,918,014 and Robinson hereinafter) and Conklin et al. (U.S. Patent # 6,363,378) in view of Weissman et al. (US Patent No. 6,453,315 B1 and Weissman hereinafter).

The teachings of Robinson and Conklin has been discussed above.

Regarding Claim 7, Robinson and Conklin does not expressly teach set of topics.

Art Unit: 2165

Weissman teaches set of topics (i.e. subject categories within a large subject directory, such as Netscape's Open Directory) (col 2, lines 25-27).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Robinson and Conklin with the teachings of Weissman to include set of topics with the motivation to aid users in finding sites or pages having information they desire ... and to leave it to the user to formulate an appropriate query (col 1, lines 23-49).

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Other Prior Art Made of Record

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. U.S. patents and U.S. patent application publications will not be supplied with Office actions. Examiners advises the Applicant that the cited U.S. patents and patent application publications are available for download via the Office's PAIR. As an alternate source, all U.S. patents and patent application publications are available on the USPTO web site (www.uspto.gov), from the Office of Public Records and from commercial sources. For the use of the Office's PAIR system, Applicants may refer to the Electronic Business Center (EBC) at <http://www.uspto.gov/ebc/index.html> or 1-866-217-9197.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Diane D. Mizrahi whose telephone number is 571-272-4079. The examiner can normally be reached on Monday-Thursday.

Art Unit: 2165

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 873-8300 for regular communications and (703) 305-3900 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



Diane Mizrahi
Primary Patent Examiner
Technology Center 2100

August 26, 2005